

REMARKS

Claims 1, 3-6, 9-12, and 15-17 are pending in the application. No amendments have been made to the pending claims. Accordingly, no new matter has been introduced by the following Remarks.

Claims 1, 3-6, 9-12, and 15-17 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent Application Publication No.: 20030119974 (hereinafter the '974 publication), and U.S. Patent Numbers 6,472,042 (Dibbern), 5,545,276 (Higgins), 5,240,530 (Fink), 5,278,272 and 5,272,236 (the Lai patents), based on a number of grounds. Applicants respectfully traverse these rejections for the reasons set forth below.

Rejection of Claims 1, 3-6, 9-12, and 15-16 over the '974 publication, Higgins and Fink

The Office Action rejects claims 1, 3-6, 9-12 and 15-16 under 35 U.S.C. § 103(a) as allegedly being obvious and unpatentable over the '974 publication further in view of Higgins and Fink. While Applicants do not agree with the merits of this rejection, Applicants submit that the '974 publication, the primary reference in this rejection, is not available for use as prior art against the current claims because the invention of the '974 publication and the claimed invention were, at the time the invention was made, owned by or subject to an obligation of assignment to the same person or organization, namely the Dow Chemical Company.

35 U.S.C. §103(c) explains that subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Further, MPEP Section 706.02(l)(1) I. states that this provision of 35 U.S.C. § 103(c)(1) is effective for all applications pending on or after December 10, 2004, and hence applies to the instant application.

As acknowledged in paragraph two of the current Office Action, Applicants statement of co-assignment of the present invention and the invention of U.S. Patent No.: 6,344,515 (Parikh) under 35 U.S.C. 103(c) was sufficient to withdraw any rejections based upon the Parikh reference. To that end, the '974 publication, which is a continuation of the cited Parikh

reference, similarly cannot be used as prior art against the present invention pursuant to any obviousness rejections because the invention of the '974 publication and the claimed invention were, at the time the invention was made, also owned by or subject to an obligation of assignment to the same person or organization, namely the Dow Chemical Company.

Pursuant to M.P.E.P. section 201.12, assignment of an original application carries title to any divisional, continuation, or reissue application stemming from the original application and filed after the date of assignment. Therefore, the obligation to assign the invention of the cited Parikh reference to the Dow Chemical Company, as reflected in the Assignment recorded on Reel 012344 and Frame 0197, also applies to the invention of the '974 publication. Further, since the '974 publication did not become publicly available until its publication date of June 26, 2003, more than 5 years after the earliest non-provisional priority date of the instant application, the '974 publication could only qualify as prior art against the current claims pursuant to the provisions of 35 U.S.C. § 102(e). Therefore, under the provision of 35 U.S.C. § 103(c)(1) set forth above, the '974 publication is not available for use as prior art against the present invention pursuant to any obviousness rejections under 35 U.S.C. § 103(a). Thus, at least due to the foregoing disqualification of Parikh as available prior art, the instant rejection of Claims 1, 3-6, 9-12 and 15-16 over the '974 publication in view of Higgins and Fink must be withdrawn.

Rejection of Claims 1, 3-6, 9-12 and 15-16 over Higgins, Fink and the Lai patents

The Office Action continues to reject claims 1, 3-6, 9-12, and 15-16 over Higgins and Fink further in view of the Lai patents. In particular, the Office Action cites Higgins as the primary reference for its general disclosure of carpets comprising primary backing tufted with face yarns of nylon, polyester, or polyolefin fibers, and an adhesive precoat or backcoat such as known hot melt adhesives. The Office Action then combines Higgins' general disclosure with Fink's background description of selection criteria for known hot melt adhesives. Based on this proposed combination, the Office Action then contends that it would have been obvious for one of ordinary skill in the art to select the specific polymer compositions disclosed in the Lai patents for use as a suitable hot melt adhesive backing in a carpet.

The instant rejection is a hindsight reconstruction of the art and is based upon a selective reading of Fink. In particular, the Office Action has selected only those portions of Fink that

will support the current obviousness rejection and has chosen to ignore the full teaching of the Fink reference. This rejection is not supportable when the disclosure of Fink is read as a whole. Further, it is improper to pick and choose from any one reference only so much of it that will support a given position without addressing the full appreciation of what the reference would suggest to one of ordinary skill in the art. *In re Wesslau*, 353 F.2d 238, 240, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

In relying on Fink, the Office Action selectively focuses on only those portions of the background section that set forth specific requirements for hot melt adhesives already known in the art. Conveniently, the Office Action ignores what the full disclosure of Fink would actually suggest to one of ordinary skill in the art. For example, the Office Action cites Fink's Background at col. 2, lines 23-30, col. 2, lines 55-64, and col. 3, lines 22-29, all of which describe known characteristics of known hot melt adhesives. The Office Action fails, however, to mention Fink's subsequent teaching that carpets comprising these "conventional" hot melt adhesives exhibit several disadvantages, including for example the inability to manufacture recyclable carpets and carpets having consistently reproducible tuft pull strengths. *See* col. 3, line 47 - col. 4, line 21. Therefore, Fink's background description as a whole clearly teaches that carpets containing these "conventional" hot melt adhesives exhibit several disadvantages. In this context, the invention of Fink seeks to provide improvements upon these stated disadvantages by providing a carpet structure comprising an isotactic polyolefin polymer adhesive that is integrally fused to the primary backing.

It is an improper selective reading to suggest that the known hot melt adhesives described in Fink as having a variety of deficiencies would provide the requisite motivation for one of ordinary skill in the art to merely select additional adhesive compositions having similar properties. Rather, in view of the shortcomings of the conventional hot-melt adhesives described in Fink, one of skill in the art could only have been motivated to ignore usage of these conventional hot-melt adhesives and seek to arrive at a carpet structure suggested by the full disclosure of Fink, namely a carpet structure comprised of an isotactic polyolefin polymer adhesive that is integrally fused to the primary backing. Furthermore, even assuming *arguendo* that Fink would have motivated one of skill in the art to select the polymeric compositions of the Lai patents for use as a hot melt adhesive, when viewed as a whole, any reliance on Fink would

still result in the skilled artisan seeking to provide a carpet structure wherein the adhesive composition is at least integrally fused to the primary backing material. In contrast however, Applicants claims are directed to a carpet or carpet tile wherein the adhesive composition is **not integrally fused** to the primary backing material. Therefore, Applicants respectfully assert that the proposed combination of Higgins and Fink in view of the Lai patents fails to render the invention of Claims 1, 3-6, 9-12 and 15-16 obvious and must be withdrawn.

Rejection of Claim 17 over the '974 publication, Higgins, Fink, and Dibbern

The Office Action has rejected claim 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the '974 publication in view of Higgins and Fink as applied to Claims 1 and 16 above, and further in view of Dibbern. While Applicants do not agree with the merits of this rejection, Applicants submit that Dibbern is also not available for use as prior art against the current claims because the invention of the Dibbern reference and the claimed invention were, at the time the invention was made, owned by or subject to an obligation of assignment to the same person or organization, namely the Dow Chemical Company.¹

As set forth above, 35 U.S.C. § 103(c) explains that subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Further, MPEP Section 706.02(l)(1) I. states that this provision of 35 U.S.C. 103(c)(1) is effective for all applications pending on or after December 10, 2004, and hence applies to the instant application.

Here, the Dibbern reference did not become publicly available until its issuance on October 29, 2002, more than 4 years after the earliest non-provisional priority date of the instant application. Therefore, the Dibbern reference only qualifies as prior art against the current claims pursuant to the provisions of 35 U.S.C. § 102(e). Further, the Dibbern reference is being applied pursuant to an obviousness rejection under 35 U.S.C. § 103(a). Therefore, under the provision of 35 U.S.C. § 103(c)(1) set forth above, the Dibbern reference is not available for use

¹ The Assignee of record for the Dibbern reference is Dow Global Technologies, Inc. To that end, Applicants note that Dow Global Technologies, Inc. is a wholly owned subsidiary of the Dow Chemical Company.

as prior art against the present invention pursuant to any obviousness rejections under 35 U.S.C. § 103(a). Thus, at least due to the disqualification of Dibbern as available prior art, any rejection of Claim 17 over Dibbern must be withdrawn.

Rejection of Claims 17 over Higgins, Fink, the Lai patents, and Dibbern

The Office Action has also rejected claim 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Higgins and Fink in view of the Lai patents as applied to Claims 1 and 16 above, and further in view of Dibbern. Once again, while Applicants do not agree with the merits of this rejection, as set forth above, Dibbern is not available for use as prior art against the current claims because the invention of the Dibbern reference and the claimed invention were, at the time the invention was made, owned by or subject to an obligation of assignment to the same person or organization, namely the Dow Chemical Company. Thus, at least due to the disqualification of Dibbern as available prior art, any rejection of Claim 17 over Dibbern must be withdrawn.

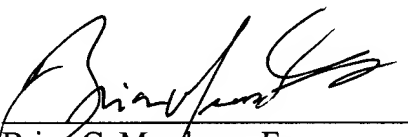
CONCLUSION

In view of the foregoing Remarks, Applicants respectfully submit that the pending claims are patentable and in condition for allowance. Accordingly, Applicants respectfully seek notification of same.

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$450.00, for the fee under 37 C.F.R. § 1.17(a)(2) is enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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Date